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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/706,849	11/07/2000	Alan S. Fisher	2043.086US2	8858
49845 7590 05/01/2007 SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH/EBAY P.O. BOX 2938 MINNEAPOLIS, MN 55402				
			EXAMINER AKINTOLA, OLABODE	
			ART UNIT 3691	PAPER NUMBER
			MAIL DATE 05/01/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/706,849	Applicant(s) FISHER ET AL.	
	Examiner Olabode Akintola	Art Unit 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>02/07/2007; 1/23/06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Terminal Disclaimer

The terminal disclaimer filed on 2/07/2007 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of Patent Number 6,243,691 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 26-34 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

With respect to claim 26, the Examiner finds the claim to lack a tangible result. In order to be a tangible result, the process must produce a real-world result. The final step of independent claim 26 states, "determining whether the bid for the at least the portion of the lot is successful or unsuccessful." This step is not considered tangible because it could be considered to be abstract or merely encompassed in thoughts. Therefore claim 26 does not produce a real world result. Amending the claim to include a step directed towards storing, printing, displaying or executing the determining step or something similar would overcome the rejection. Claims 27-34 contain language that also fail to produce a real world result and are therefore rejected as failing to produce a tangible result as discussed above for claim 26.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 18-19, 21-22, 24, 26-27, 29-30, 32-33, 35-36, 38-39, 41-42, 44-45, 47-48, 50-51 are rejected under 35 U.S.C. 102(e) as being anticipated by Woolston (5845265) (“Woolston”).

Re claims 18, 26, 35 and 44: Woolston teaches computer system for conducting an auction through a computer network, the system comprising: a posting means for posting to a computerized merchandise catalog information that is accessible through the computer network, the information describing each lot in a plurality of lots available for auction, each lot including at least one item (col. 3, lines 8-67, col. 4, lines 10-27, col. 5, lines 48-55), the posting means available to add a lot for auction during an auction of another lot, wherein the information related to items in each lot is substantially continuously updated in the merchandise catalog as items in each lot are made available for auction (col. 7, lines 16-30); a bid receiving means for receiving a bid for at least a portion of a lot of the plurality of lots (col. 6, lines 21-29); a bid validation means for examining the bid (col. 6, lines 37-44); and a bid categorizing means for determining whether the bid is successful or unsuccessful (col. 6, lines 30-33, col. 10, lines 33-63).

Art Unit: 3691

Re claims 19, 27, 36 and 45: Woolston teaches an auction selection means for associating each lot of the plurality of lots with an auction format selected from a plurality of auction formats (col. 5, line 50)

Re claims 21, 29, 38 and 47: Woolston teaches wherein bid-receiving means receives the bid from a bid form (col. 11, line 52-67 and Figures 5-8)

Re claims 22, 30, 39 and 48: Woolston teaches wherein the posting means is adapted to receive a message posted through the computer network corresponding to a lot and to post the message in association with the descriptive information for that lot.

(Figure 13)

Re claims 24, 32, 33, 41, 42, 50 and 51: Woolston teaches wherein the bid receiving means is for receiving bids on at least two lots that are simultaneously open for auction, the at least two lots having different associated auction formats, and wherein the bid categorizing the means is for automatically categorizing the received bids as successful or unsuccessful in accordance with the associated auction format for each lot (col. 11, lines 6-10).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3691

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 25, 34, 43 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woolston.

Re claim 25, 34, 43 and 52: Woolston does not explicitly teach proxy bidding. Official notice is hereby taken that the concept of proxy bidding is old and well known in the art at the time of the invention. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Woolston to include this feature. One would have been motivated to do so in order allow participant the set maximum bids without monitoring the auction.

Claims 20, 28, 37 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woolston in view of Huberman (US 5826244) ("Huberman").

Re claims 20, 28, 37 and 46: Woolston does not explicitly teach an auction format of the plurality of auction formats comprises one selected from the group comprising: Dutch auction, standard auction, progressive auction, and buy or bid auction.

Huberman teaches an auction format of the plurality of auction formats comprises one selected from the group comprising: Dutch auction, standard auction, progressive auction, and buy or bid auction (col. 10, lines 48-61).). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Woolston to include this feature as taught by Huberman. One would have been motivated to do so in order to allow for flexibility taking into account customer preferences and the nature and characteristics of the item being auctioned.

Claims 23, 31, 40 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woolston in view of Micali (US 5553145) ("Micali")

Re claim 23, 31, 40 and 49: Woolston does not explicitly teach wherein the message received and posted by the posting means includes a text message from a bidder corresponding to a lot. Micali teaches wherein the message received and posted by the posting means includes a text message from a bidder corresponding to a lot (col. 14, lines 1-19 and 32-37). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Woolston to include this feature as taught by Micali. One would have been motivated to do so in order to allow the participants to send messages along with the bids.

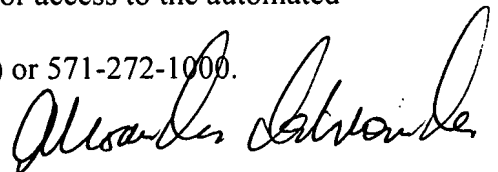
Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Fraser et al (US 5329589) teaches a bid validation means for examining the bid (col. 14, lines 16-28).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olabode Akintola whose telephone number is 571-272-3629. The examiner can normally be reached on M-F 8:30AM -5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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